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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,345	03/23/2001	Byung-in Ma	1293.1197	4409

21171 7590 10/23/2003

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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 10/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,345

Applicant(s)

MA ET AL.

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 6-7, 10-11, 15, 21, 22, 26, 27, 29 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5, 8-9, 12-14, 16-20, 23-25, 28, 30-33 and 37-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restriction

1. Claims 6-7, 10-11, 15, 21-22, 26-27, 29 and 34-36 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to figs. 3-10 and 13-15 [for second to fourth embodiment]. Election was made with traverse of claims 1-5, 8-9, 12-14, 16-20, 23-25, 28, 30-33 and 37-39 of species **b** of fig. 6.

NOTE: It is assumed that typographical error was made and the Applicants are NOT electing claims 30-35 [among other claims] but are electing 30-33, since claims 34 and 35 are dependent on non-elected claim 29.

Applicant's election with traverse of group b in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "There have been no references cited to show any necessity for requiring restriction. ... the Examiner has not provided evidence of undue burden as set forth in MPEP 802.02 such that prima facie case for restriction or election has not been provided".

This is not found persuasive because, the Examiner does not need to show separate classification or field of search for election of the species requirement. See 803.00 and 808.01(a); M.P.E.P.

As to the argument regarding claims 1, 8, 19 and 37 are generic, the Applicants may be correct and these claims will be treated as such. The requirement is still deemed proper and is therefore made **FINAL**.

2. further restriction on the remaining claims 1-5, 8-9, 12-14, 16-20, 23-25, 28, 30-33 and 37-39 of species b, to one of the following inventions is required under 35 U.S.C. 121:

A. Claims 1-5, 8-9, 12-14, 16-18 are drawn to an apparatus to generate a seek direction detecting signal, and claims 37-39 are drawn to method for generating a seek direction, classified in Class 369, subclass 44.28.

B. Claims 19-20, 23-25, 28 and 30-33 are drawn to an optical pickup apparatus to record/reproduce to/from an optical disk , classified in Class 369, subclass 44.37.

Inventions B and A are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the optical pickup does not require an apparatus to generate a seek direction. The subcombination has separate utility such as generating a seek direction detecting signal by various methods. Because these inventions are distinct for the reasons given above and the search required for Group A is not required for Group B, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Mr. Michael Stein on October 21, 2003; to request an oral election to the above restriction requirement, but did not result in an election being made.

NOTE: Mr. Stein said that restriction is possible, however he requested that a formal restriction be sent out for examination of the client.

Art Unit: 2655

4. Applicant is reminded that **upon the cancellation of claims to a non-elected invention, the inventorship must be amended** in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. A shortened statutory period for response to this action is set to expire **1 (one) months** and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.



Gautam R. Patel
Patent Examiner
Group Art Unit 2655

October 21, 2003